

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

Baker et al.

Docket No:

39780-2830P1C7

Serial No:

10/006,130

Group Art Unit:

1647

Filed:

December 6, 2001

Examiner:

Rachel B. Kapust

For:

SECRETED AND TRANSMEMBRANE POLYPEPTIDES AND NUCLEIC

ACIDS ENCODING THE SAME

Commissioner for Patents Washington, D.C. 20231

## DECLARATION OF AUDREY GODDARD, Ph.D. UNDER 37 CFR 1.131

- I, Audrey Goddard, Ph.D. do hereby declare and say as follows:
- I am Senior Clinical Scientist at the Diagnostics, Development Sciences Department 1. of Genentech, Inc., South San Francisco, CA 94080.
- I am one of the inventors of the above-identified application. 2.
- I have read and understood the claims pending in this application, and are aware that 3. the claims have been rejected as anticipated by U.S. Patent Publication No. 2003/0096951 (Jacobs et al., publication date May 22, 2003 and effective filing date August 14, 1998).
- I, along with other inventors of this application, conceived and reduced to practice the 4. polypeptide designated as PRO1244 (SEQ ID NO:130) claimed in the above-identified application in the United States prior to August 14, 1998.
- At the time the PRO1244 polypeptide was cloned and sequenced I was responsible for 5. overseeing the sequencing of novel polypeptides, including the PRO1244 polypeptide (SEQ ID NO:130) claimed in the above-identified application.
- A cDNA clone, referred to as DNA64883-1526 in the above-identified application, 6. was identified as encoding the PRO1244 polypeptide.
- 7. The full length of the cDNA clone is shown in Figure 73 of the above-identified application. The full-length cDNA sequence has 2213 nucleotide residues. The full length of the PRO1244 peptide encoded by DNA64883-1526 is shown in Figure 74 of

- the above-identified application. The full-length PRO1244 polypeptide has 335 amino acid residues.
- 8. Copies of the pages from the GSeqEdit database which report the cloning and sequencing data for the PRO1244 polypeptide sequence and its encoding nucleic acid sequence are attached to this declaration (with the dates redacted) as Exhibit A.
- 9. The GSeqEdit report shows the full-length nucleic acid sequence for DNA-64883-1526 (identified as "DNA-64883") and the full-length PRO1244 polypeptide encoded by DNA 64883. Both the DNA-64883 and the PRO1244 polypeptide sequences were obtained prior to August 14, 1998.
- The DNA-64883 sequence shown in the GSeqEdit report is identical to that of SEQID NO: 129 disclosed in the above-identified application.
- 11. The beginning of the cDNA sequence corresponding to SEQ ID NO: 129 in the above-identified application is shown on page 1 of the GSeqEdit database report and the location of the first nucleotide is marked with "^insert starts here" and an arrow. The location of the last nucleotide corresponding to SEQ ID NO: 129 is shown on page 11 and is marked with an arrow.
- 12. The amino acid sequence shown in the GSeqEdit report is identical to that of SEQ ID NO: 130 disclosed in the above-identified application.
- 13. The first 26 amino acid residues of the PRO1244 polypeptide (SEQ ID NO:130) encoded by the cDNA (DNA-64883) are also shown on page 1 of the GSeqEdit report and the remaining 309 residues appear on pages 2-6 of the report.
- 14. Exhibit A clearly shows that both the full-length DNA-64883 sequence and the full-length PRO1244 polypeptide sequence disclosed in the above-identified application were obtained prior to August 14, 1998.
- 15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information or belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001

of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

Audrey Goddard

Date

SV 2037583 v1 6/15/04 3:02 PM (39780.2830)



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ACIDS ENCODING THE SAME

Commissioner for Patents Washington, D.C. 20231

## DECLARATION OF WILLIAM WOOD, Ph.D. UNDER 37 CFR 1.131

- I, William Wood, Ph.D. do hereby declare and say as follows:
- I am Director and Staff Scientist at the Department of Bioinformatics, of Genentech, 1. Inc., South San Francisco, CA 94080.
- 2. I am one of the inventors of the above-identified application.
- I have read and understood the claims pending in this application, and are aware that 3. the claims have been rejected as anticipated by U.S. Patent Publication No. 2003/0096951 (Jacobs et al., publication date May 22, 2003 and effective filing date August 14, 1998).
- 4. I, along with other inventors of this application, conceived and reduced to practice the polypeptide designated as PRO1244 (SEQ ID NO:130) claimed in the above-identified application in the United States prior to August 14, 1998.
- At the time the PRO1244 polypeptide was cloned and sequenced I was responsible for 5. overseeing the cloning of cDNAs which encoded novel polypeptides, including the cDNA that encoded PRO1244 polypeptide (SEQ ID NO:130) claimed in the aboveidentified application.
- A cDNA clone, referred to as DNA64883-1526 in the above-identified application, 6. was identified as encoding the PRO1244 polypeptide.
- The full length of the cDNA clone is shown in Figure 73 of the above-identified 7. application. The full-length cDNA sequence has 2213 nucleotide residues. The full

- length of the PRO1244 peptide encoded by DNA64883-1526 is shown in Figure 74 of the above-identified application. The full-length PRO1244 polypeptide has 335 amino acid residues.
- 8. Copies of the pages from the GSeqEdit database which report the cloning and sequencing data for the PRO1244 polypeptide sequence and its encoding nucleic acid sequence are attached to this declaration (with the dates redacted) as Exhibit A.
- 9. The GSeqEdit report shows the full-length nucleic acid sequence for DNA-64883-1526 (identified as "DNA-64883") and the full-length PRO1244 polypeptide encoded by DNA 64883. Both the DNA-64883 and the PRO1244 polypeptide sequences were obtained prior to August 14, 1998.
- The DNA-64883 sequence shown in the GSeqEdit report is identical to that of SEQID NO: 129 disclosed in the above-identified application.
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- 13. The first 26 amino acid residues of the PRO1244 polypeptide (SEQ ID NO:130) encoded by the cDNA (DNA-64883) are also shown on page 1 of the GSeqEdit report and the remaining 309 residues appear on pages 2-6 of the report.
- 14. Exhibit A clearly shows that both the full-length DNA-64883 sequence and the full-length PRO1244 polypeptide sequence disclosed in the above-identified application were obtained prior to August 14, 1998.
- 15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information or belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and

the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

William Wood

Date

SV 2037583 v1 6/9/04 1:21 PM (39780.2830) Exhibit A to Declarations of Audrey Goddard and William Wood under 37 CFR 1.131

GSeqEdit Database Report

>human ortholog of implantation-associated protein - Rattus DNA64883 sheldens GSeqEdit DNA64883 goddarda GSeqEdit DNA64883 zemin GSeqEdit DNA64883 wiw GSeqEdit >510 Sites [All Sites] >DNA64883 [Full]

>HBN64883.seq, sequenced at ABI/ACGT by Peter Ma and Ellson Chen

maeII/hpyC hpy99I mnll 1 CGGAATICGG CICGAGGAGC GAACAIGGCA GCGCGTIGGC GGTTITGGIG IGTCICIGIG ACCAIGGIGG IGGCGCIGCI CAICGIIIGC GACGIICCCI GCCTTAAGCC GAGCTCCTCG CTTGTACCGT CGCGCAACCG CCAAAACCAC ACAGAGACAC TGGTACCACC ACCGCGACGA GTAGCAAACG CTGCAAGGGA taiI fnu4HI/bsoFI hhal/cfol tseI Ivqq hinPI haeII btgI/bstDSI nlaIII mslI bstXI bsaJI dsaI styl ncol tsp45I bsmAI maeIII tseI bstUI[M.hhaI-] hinPI acil fnuDII/mvnI bbvI bsh1236I nlaIII hhaI/cfoI fnu4HI/bsoFI MAARW thaI aval[M.taqI-] paeR71 mwoI tsp5091[M.ecoRI-] apol mwol bseRI mnll taqI xhoI tliI smll ecoRI

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|      |              | bsaXI         |
| mnll | alwNI[dcm-]. | alw261/bsmAI  |

bsmAI 101 CAGCCTCTGC CCAAAGAAAG AAGGAGATGG TGTTATCTGA AAAGGTTAGT CAGCTGATGG AATGGACTAA CAAAAGACCT GTAATAAGAA TGAATGGAGA GICGGAGACG GGTITCTITC TICCICIACC ACAATAGACI TITCCAATCA GICGACIACC ITACCIGAIT GIITICIGGA CATTAITCIT ACTIACCICI C C z بم. œ × z 3 O L M E တ > LSE X E **64** A S A 27

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|       | ч  | 166Kd4   | 16     |      |      |       |      |          | ts. | tsp509I     | <b>H</b> |       |       | nlaIII | II    |          |                             | hp       | CH4     | hpyCH4V tspRI | pRI   |                  | h     | hpvCH4V al | al     |
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GSeqEdit, DNA64883 [Full], page 2

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                                                                                               hpyCH4V
                                                                                                                                     bssKI[dcm-]
                                                                           ecoRII[dcm-]
                    scrFI[dcm-]
                                                                                                                 bstNI bael
                                                                                              dsaV[dcm-]
                                       pspGI
                                                          mvaI
                                                                          alw26I/bsmAI
dpnI[dam+]
                                     bstYI/xhoII
                                                                                             tsp5091[M.ecoRI-]
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mbol/ndell[dam-]

sau3AI

dpnII[dam-]

ecoRII[dcm-]

dsaV[dcm-]

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bssKI[dcm-] apy1[dcm+]

scrFI[dcm-]

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CGACTACITC ITAAGGICIA GGACCGIIIG AGGACCGCIA TGAGGICACG TAAGIGGIIG ICCIAIAAAA AACGGIACCA CCIAAAAACTA CIICCGAGAC

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tsp5091[M.ecoRI-]

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**DSmFI** sau96I nlaIV

501 GGGTTTTTCA GCTGAGCAGA TTGCCCGGTG GATCGCCGAC AGAACTGATG TCAATATTAG AGTGATTAGA CCCCCAAATT ATGCTGGTCC CCTTATGTTG CCCAAAAAGI CGACTCGICI AACGGGCCAC CTAGCGGCTG TCTTGACTAC AGTTATAATC TCACTAATCT GGGGGTTTAA TACGACCAGG GGAATACAAC Σ avall bslI tsp509I IAD bssKI alwI[dam-] mspAll/nspBII E

fnu4HI/bsoFI aluI mwoI hpyCH4V tseI Inqq bstF5I fokI bsrI tru9I mseI tsp5091 apoI IIodm IIodm bsici bstBI taqI sfuI

CCTAACGAAA ACCGACAATA ACCACCTGAA CACATAGAAG CTTCTTCATT ATACCTTAAA GAGAAATTAT TTTGACCTAC CCGAAAAGT CGAAACACAA 601 GGATTGCTIT TGGCTGTTAT TGGTGGACTT GTGTATCTTC GAAGAAGTAA TATGGAATTT CTCTTTAATA AAACTGGATG GGCTTTTGCA GCTTTGTGTT ပ G G L L 193

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| nlalli | styI | ncol  | dsaI   | btgI/bs | tsp5091 bsaJI | 701 TIGIGCITGC TATGACATCT GGTCAAATGT GGAACCATAT AAGAGGACCA CCATATGCCC ATAAGAATCC CCACACGGGA CATGTGAATT ATATCCATGG | AACACGAACG ATACTGTAGA CCAGTTTACA CCTTGGTATA TTCTCCTGGT GGTATACGGG TATTCTTAGG GGTGTGCCCT GTACACTTAA TATAGGTACC | 5   |
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| I      |      |       |        |         | 4             | FIGA  | ACT   | z<br>_  |
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|        |      |       |        |         |               | AAGA  | TTCT  | W N H I R G P P Y A H K N P H T G H V N Y I H G |
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|        |      |       |        |         | 1105          | SGTC  | CAG   | <i>(</i> n                                      |
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**DSmFI** 

bsrI sau96I

bpmI/gsuI[dcm-] rsal nlaIV avaII

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ddeI[M.aluI-]

apoI

bstF5I 1401 GAIGGGGAAA GIAAGICCIG ACCAGGIGIT CCCACATAIG CCIGITACAG ATAACTACAI TAGGAAITCA ITCITAGCII CITCAICITI GIGIGGAIGI CTACCCCTTT CATTCAGGAC TGGTCCACAA GGGTGTATAC GGACAATGTC TATTGATGTA ATCCTTAAGT AAGAATCGAA GAAGTAGAAA CACACCTACA maeIII ndeI hpy188III

taiI

hgiAI/aspHI

**bsp1286** 

rmal ddel **DSIHKAI** 

hpy188I maeII/hpyCH4IV hpy1881 mboll

bpuAI

nlaIII bbsI

tsp5091

bst1107I bst217I

accI

mboll bmyl btri bfal mnll

aflii maei bspC

eco57I

CATATGAAAT GCGTAGAAAG GAAAACTCAT CTCTTTAATA CACACAGTAC ACCAGAAGAC TTTTACCTTG TGGTAAGAAG TCTCGTGTGC AGATCGGAG 1501 GIATACTITA CGCATCTITC CITITGAGIA GAGAAATIAI GIGIGICAIG IGGICTICIG AAAAIGGAAC ACCATICIIC AGAGCACACG ICIAGCCCIC

tth11111/aspI

pleI

pflFI

mlyI

bpmI/gsuI[dcm-]

bseRI mnll bseRI

hinPI

hinfI

bsmAI

1601 AGCAAGACAG TIGITICICC ICCICCTIGC ATAITICCIA CIGCGCICCA GCCIGAGIGA TAGAGIGAGA CICIGICICA AAAAAAAGIA ICICIAAAIA TCGTTCTGTC AACAAAGAGG AGGAGGAACG TATAAAGGAT GACGCGAGGT CGGACTCACT ATCTCACTCT GAGACAGAGT TTTTTTCAT AGAGATTTAT bsmAI hhal/cfol bspCNI bst4CI/hpyCH4III mnll hpyCH4V

tru9I

tfiI

tru9I maeIII hphI

tsp45I

hincII/hindII hpaI

tsp5091

msel

hinfI asp700 XmnI

hpy188I

ddeI

msel bstEII

GTCCTAATAT TAAAGACGAA CTCATACCAC AATTGATGGA ACATAAATCT TTCTAAAGTC TAAGTAAGGT AGAGGAATCA AAAGAAAATT CCACTGGGTA 1701 CAGGATTATA ATTICÍGCTI GAGTAIGGIG ITAACTACCI IGTATITAGA AAGATTICAG ATICATICCA ICICCITAGI ITICITITAA GGIGACCCAI

haeIII/palI

maeIII

ddeI[M.aluI-]

nlaIII

tspRI

tsp5091

maeIII

tsp45I

csp6I rsal

dde

GACACTATIT TIAIATCGAA TCACGATITI AGTCACATIG AATATGTACC GGATTITACA AAGATGTTTA ATCTCAAACA GTGAATAAGG TAAACATGGA 1801 CIGIGATAAA AATATAGCIT AGIGCTAAAA TCAGIGIAAC TTATACAIGG CCTAAAAIGI ITCTACAAAI TAGAGITIGI CACTTATICC AITIGIACCI

```
styl cac81
                                                                                                                                                                                                                                                                         haeIII/palI
                                                                                                                                                                                               tsp45I
                                                                                                                                                                                                               maeIII
                                                                                                                                                                                                                                                          pleI bslI[dcm-] hhaI/cfoI
                                                                                                                                                                                                                                           bssKI[dcm-] tspRI
                                            ecoRII[dcm-]
                                                                                                       mscI/ball[dcm-]
scrFI[dcm-]
                                                                                                                                                                                 mvaI bssKI[dcm-]
                                                                                                                                                                                                                             hinPI
                                                                                                                                                                                                                                                                         mlyI bsaJI apyI[dcm+]
                                                          dsaV[dcm-]
                                                                                        haeIII/palI
                                                                                                                                                                                               ecoRII[dcm-]
                                                                                                                     eaeI[dcm-]
                                                                                                                                                   scrFI[dcm-]
                                                                                                                                                                                                              dsaV[dcm-]
                                                                         bstNI
               pspGI
                              mvaI
                                                                                                                                    cfrI
                                                                                                                                                                                                                            bstNI
                                                                                                                                                                  pspGI
```

hpy18 bssS

sau3AI

dpnII[d mboI/nd

dpnI[da

mnll bsaJI

**bspCNI** 

1901 AAGAGAAAAA TAGGCTCAGI TAGAAAAGGA CICCCTGGCC AGGCGCAGTG ACTTACGCCT GTAATCICAG CACTITGGGA GGCCAAAGGCA GGCAGAICAC

hinf! apyl[dcm+] bts!

bspCNI

TICTCITITI AICCGAGICA AICITITCCI GAGGGACCGG ICCGCGICAC IGAAIGCGGA CAITAGAGIC GIGAAACCCI CCGGIICCGI CCGICTAGIG

2001 GAGGICAGGA GIICGAGACC AICCIGGCCA ACAIGGIGAA ACCCCGICTC TACTAAAAAT AIAAAAAITA GCIGGGIGIG GIGGCAGGAG CCIGIAAICC CICCAGICCI CAAGCICIGG IAGGACCGGI IGIACCACII IGGGGCAGAG AIGAITITIA IAITITIAAI CGACCCACAC CACCGICCIC GGACAITAGG aluI tsp509I bsmAI esp3I bsmBI hpy188III apy1[dcm+] hphI mscI/ball[dcm-] nlaIII hpy188III bsaI bstF5I haeIII/palI eael[dcm-] ecoRII[dcm-] bssKI[dcm-] scrFI[dcm-] dsaV[dcm-] taqI fokI cfrI bstNI pspGI mvaI bsmAI

GTCGATGIGT CCTCCGACTC CGTGCTCTTA GTGAACTTGA GTCCTCTACC TCCAAAGTCA CTCGGCTCTA GTGCGGTGAC GTGAGGTCGG ACCGTTGTCT 2101 CAGCTACACA GGAGGCTGAG GCACGAGAAT CACTTGAACT CAGGAGATGG AGGTTTCAGT GAGCCGAGAT CACGCCACTG CACTCCAGCC TGGCAACAGA ecoRII[dcm-] bssKI[dcm-] apyI[dcm+] dsaV[dcm-] dpnI[dam+] bsgI bpmI/gsuI[dcm-] bstNI dpnII[dam-] hpyCH4V mbol/ndeII[dam-] tspRI btsI sau3AI tspRI mnlI hpy188III **bspcNI** ddeI hinfI tfiI mnli mnli bssSI DSPCNI ddeI

aluI

scrFI[dcm-]

nlaIV

pspGI

mvaI

fnu4HI/bsoFI

haeIII/palI

mcrI

eagI/xmaIII/eclXI

eaeI

cfrI

bsiEI

rmaI

mael notI

fnu4HI/bsoFI bfaI

hinfI

bsmAI

plei mlyI

2201 GCGAGACTCC ATCTCAAAAA AAAAAAAA AAAAAAAA AAAAAAAGG CGGCCGCCGA CTAGTGAGC acil acil

CGCTCTGAGG TAGAGTTTTT TTTTTTTT TTTTTTT TTTTTTCC GCCGCCGCT GATCACTCG

> length: 2269

accI (GTMKAC):

acil(CCGC):

780 1586

278 714 1150

aflili (ACRYGT): ahalil (TTTAAA):

ahdI (GACNNNNNGTC):

aluI (AGCT):

alw261 (CAGNNNCTG):

alwni (CAGNNNCTG): alwi (GGATCNNN):

apol (RAATTY): apyI (CCWGG):

asp700 (GAANNNTTC):

aspHI (GWGCWC):

1464 1749

101 316